

REMARKS

This application has been carefully reviewed in light of the non-final Office Action dated February 28, 2008. Claims 7, 8, 21 to 34, and 42 have been cancelled, without prejudice or disclaimer of subject matter. Claims 1, 6, 20, 35, 40, and 46 have been amended and claims 54 to 70 have been added. Support for the amendments and new claims may be found throughout Applicants' specification, for example, at page 17, line 5 through page 38, line 7. Claims 1 to 6, 9 to 20, 35 to 41, and 43 to 70 remain in the application, of which claims 1, 20, and 35 are the independent claims. Reconsideration and further examination are respectfully requested.

Interview Summary

Initially, the Applicants' undersigned representative thanks Examiner Mansfield and Examiner Tarae for the thoughtful courtesies and kind treatment afforded during the personal interview conducted on May 14, 2008. During the interview, Examiner Mansfield, Examiner Tarae, and Applicants' representative discussed amended independent claim 35 with respect to the cited references. Examiner Mansfield and Examiner Tarae agreed that the amendments to independent claim 35 appear to overcome the cited references. This reply reflects the substance of the interview.

Drawings Objection

New corrected drawings in compliance with 37 CFR 1.121(d) were required because the drawings include hand-drawn numbering and illustrations. Applicants have submitted new drawings in compliance with 37 CFR 1.121(d) and, therefore, respectfully request reconsideration and withdrawal of this objection.

Claims Objection

Claim 46 was objected to because of an informality. Applicants have amended claim 46 as kindly suggested in the Office Action and, therefore, respectfully request reconsideration and withdrawal of this objection.

§ 102 and § 103 Rejections

Claims 1-53 were rejected over Mechling et al., "Defining and Measuring Success In Canadian Public Sector Electronic Service Delivery," Issue Paper Prepared for Discussion and Debate at Lac Carling V, April 24, 2001 alone or Mechling in view of Spears et al., "Citizens First 2000," Public Sector Service Delivery Council and The Institute of Public Administration of Canada, (2001) and Official Notice. Based on the discussion in the personal interview conducted on May 14, 2008 and the following remarks, withdrawal of the rejections and further examination are respectfully requested.

Referring to particular claim language, independent claim 35, as amended, recites a method comprising accessing, from electronic storage, a public sector value model that corresponds to a public sector organization and that defines at least two outcome measures that correspond to outcomes achieved by the public sector organization, weightings that correspond to each of the outcome measures and that define a relative weight given to the corresponding outcome measure, and at least one cost-effectiveness measure that relates to costs incurred by the public sector organization in achieving the outcomes. The method also includes obtaining measurements corresponding to the at least two outcome measures and the at least one cost-effectiveness measure and computing, using the public sector value model, a performance value and a cost-effectiveness value based on the obtained measurements and the weightings defined in the public sector value model. A relative public performance measure of the public sector organization is determined based on the computed performance value, an average performance value relevant to the public sector organization, the computed cost-effectiveness value, and an average cost-effectiveness value relevant to the public sector organization.

Independent claims 1 and 20, as amended, recite features similar to those discussed above with respect to independent claim 35, but do so in the context of a computer system and a computer program product.

The applied references are not seen to disclose, teach or suggest the foregoing features recited by the independent claims. In particular, as discussed in the personal interview of May 14, 2008, Mechling, Spears, and a proper combination of the two, each fail to describe or suggest computing, using the public sector value model, a performance value and a cost-effectiveness value based on the obtained measurements and the weightings defined in the public sector value

model, and determining a relative public performance measure of the public sector organization based on the computed performance value, an average performance value relevant to the public sector organization, the computed cost-effectiveness value, and an average cost-effectiveness value relevant to the public sector organization.

Based on the these remarks and the discussion in the personal interview conducted on May 14, 2008, independent claims 1, 20, and 35 are believed to be allowable over the applied references. The other rejected claims and new claims in the application are each dependent on these independent claims and are thus believed to be allowable over the applied references for at least the same reasons. Because each claim is deemed to define additional aspects of the disclosure, however, the individual consideration of each claim on its own merits is respectfully requested.

In addition, Applicants submit that nothing in this response should be construed as a concession of the Official Notice (or "Official Action") taken in the Office Action. Under MPEP § 2144.03(A), official notice may only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. *See* MPEP § 2144.03(A). More to the point, an Examiner is prohibited from taking official notice of facts without citing a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. *See id.* In the instant case, Applicants respectfully assert that the features cited by the Office Action as being obvious or well-known are not capable of instant and unquestionable demonstration. Having failed to locate these features after either conducting an exhaustive reference search or reviewing the Applicants cited references, Applicants respectfully assert that these features are ineligible for official notice, and further request that the Examiner provide documentary evidence if the rejection is to be maintained. *See* MPEP § 2133.03(C). Thus, to the extent necessary, Applicants traverse all of the Official Notice taken in the Office Action and respectfully request provision of a reference in the prior art, in the context of the pending claims, for the features rejected on the basis of Official Notice.

Furthermore, with regard to the proposed combination of Mechling and Spears, the Applicants note that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness.” *See In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006). In fact, “a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning.” *KSR Int’l v. Teleflex Inc.*, 82 USPQ 2d 1385, at 1397 (2007). In the present instance, the Applicants submit that the statements presented in the Office Action to support the proposed combination are exactly the type of “conclusory statement” that the Federal Circuit has directed are insufficient to support an obviousness determination. Moreover, since a combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose, the Applicants submit that the combinations proposed by the Examiner would clearly change the principle of operation in each case, and note the lack of articulated reasoning in the Office Action that would suggest otherwise. *See* MPEP § 2143.01. For these and other reasons, any and all proposed combinations of references suggested in the Office Action are believed to be improper and the Examiner has not established a *prima facie* case of obviousness.

All of the pending issues have been addressed. However, the absence of a reply to a specific rejection, objection, issue, or comment, including the Office Action’s characterizations of the reference, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation. Since the amendments made herein have been made solely in an effort to expedite advancement of this case, the Applicants reserves the right to prosecute the rejected claims in further prosecution of this or related applications.

No other matters being raised, it is believed that the entire application is fully in condition for allowance and such action is courteously solicited.

Applicant : Lisa H. Neuberger et al.
Serial No. : 10/664,797
Filed : September 16, 2003
Page : 20 of 20

Attorney's Docket No.: 12587-038001 / 01476-00/US

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: May 27, 2008

/Jeremy J. Monaldo/

Jeremy J. Monaldo

Reg. No. 58,680

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

40494111.doc